

Serial No.: 09/872,770
Filed: June 01, 2001

REMARKS/ARGUMENTS

In that Action, the Examiner imposed a restriction as between:

- I. Claims 1-12 and 26-27, drawn to a polymer membrane, classified in class 204, subclass 522.
- II. Claims 13, 14 and 1, drawn to a membrane electrode assembly, classified in class 429, subclass 206.
- III. Claims 15-16, 19 and 1, drawn to an electrochemical device such as a battery, classified in class 429, subclass 122.
- IV. Claims 17-18, 13-14, 20 and 1, drawn to a fuel cell, classified in class 429, subclass 41.
- V. Claims 21 and 1, drawn to a method of forming the polymer membrane, classified in class 521, subclass 27.
- VI. Claims 22, 23 and 1, drawn to a method of forming a membrane electrode assembly, classified in class 502, subclass 101.
- VII. Claims 24-25, drawn to a method of making a polymer membrane, classified in class 521, subclass 27.
- VIII. Claims 28, 29 and 26, drawn to a membrane electrode assembly, classified in class 429, subclass 206.
- IX. Claims 28, 29 and 27, drawn to a membrane electrode assembly, classified in class 429, subclass 206.
- X. Claims 30, 31 and 26, drawn to an electrochemical device, classified in class 429, subclass 122.
- XI. Claims 30, 31 and 27, drawn to an electrochemical device, classified in class 429, subclass 122.
- XII. Claims 32, 34 and 26, drawn to a fuel cell, classified in class 429, subclass 41.
- XIII. Claims 32, 34 and 27, drawn to a fuel cell, classified in class 429, subclass 41.
- XIV. Claims 33, 34 and 28, drawn to a fuel cell, classified in class 429, subclass 41.
- XV. Claims 33, 34 and 29, drawn to a fuel cell, classified in class 429, subclass 41.

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Applicant hereby elects Group I, claims 1-12 and 26-27, drawn to a polymer membrane, classified in class 204, subclass 522 but only to claims 1-12. Claims 26-27 are withdrawn from consideration at this time.

Applicant traverses the restriction of Groups I through VI. The Examiner has asserted that Group I and Groups II-IV are related as a combination and subcombination wherein the Examiner has asserted that (1) the combination as claimed does not require the particulars of the subcombination for patentability and (2) the subcombination has utility by itself or in other combinations.

Applicant has amended the claims to call for "a polymer electrolyte membrane" rather than "membrane." As indicated in the application at page 1, lines 7-8, polymer electrolyte membranes are useful in electrochemical devices such as batteries and fuel cells since they function as electrolyte and separator. As amended the subcombination is a polymer electrolyte membrane and the combination refers to that polymer electrolyte membrane (Group I) in combination with other components to form the combinations set forth in claims 13-20 (Groups II-IV). All of claims 1-20 ultimately depend upon the polymer electrolyte membrane of claim 1.

However, membrane electrode assemblies, electrochemical devices and fuel cells having polymer electrolyte membranes are well known in the art. Accordingly, the novelty of claims 1-20 relies primarily upon the novel polymer electrolyte membrane as set forth in amended claim 1. As such, the first requirement of MPEP 806.05(c) has not been met.

The second requirement of 806.05(c) has also not been met since the polymer electrolyte membranes as set forth in claims 1-23 are not "membranes" which are readily utilizable alone or in other combinations. The restriction of Groups I through IV is therefore inappropriate.

The Examiner also asserts that Groups II-IV are mutually exclusive species in an intermediate-final product relationship relying upon MPEP 806.04(b), third paragraph. However, paragraph one of MPEP 806.04(b) states that "the question of restriction must be determined by both the practice

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applicable to the election of species and the practice applicable to other types of restrictions such as those covered in MPEP 806.05 – 806.05(i). If restriction is improper under either practice, it should not be required.” (Emphasis added.) As already pointed out, the restriction of the claims between inventions I through IV is based on the combination and subcombination as set forth in MPEP 806.05(c). As already pointed, this restriction is improper. Further, the other sections under 806.05 do not appear to be more applicable than the restriction already raised. Accordingly, Groups I through IV should be combined for further prosecution.

Inventions I and V are asserted to be distinct because (1) the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process.

This restriction is inappropriate since the claims of the different groups are not related as a process for making a polymer electrolyte membrane and a claim to a polymer electrolyte membrane made according to the method of claim 21. Rather, the claims of Group I are directed specifically to the polymer electrolyte membrane per se while claim 21 of Group V calls for the method of making the polymer electrolyte membrane of claim 1. Notwithstanding this distinction, the Examiner has taken the position that the polymer electrolyte membrane of claim 1 can be made by another material and different process such as combining the materials at an elevated temperature and/or in a specific solvent mixture. Applicants disagree. Claim 21 is an open ended claim which is broad enough to cover the two proposed “materially different processes.” Further, the process is limited to making the polymer electrolyte membrane of claim 1 and cannot be used to make others. As such, the first and second requirements of MPEP 806.5(f) have not been met and therefore restriction as between Groups I and V is improper.

The Examiner asserts that Groups V and VI are unrelated. The issue is not whether inventions V and VI are unrelated but rather whether the claims of Group VI are related to Groups I and II. As amended, claims 22 and 23 of Group VI are related to the inventions of Group I and the membrane

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electrode assemblies of Group II. This situation is similar to the relationship between Groups I through IV as argued above.

CONCLUSION

Based upon the foregoing, it is submitted that Groups I through VI should be examined together in this application.

The Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. A-70610/468940-10/RFT).

Respectfully submitted,

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